

REMARKS

In the final Office Action,¹ the Examiner:

- (a) rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- (b) rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki et al. (U.S. Patent Publication No. 2003/0153958) ("Yamazaki") in view of Ya Man LTD (JP 2000-060977) ("Ya Man LTD"); and
- (c) rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Ya Man LTD, and further in view of Granek et al. (U.S. Patent No. 4,729,377) ("Granek").

Applicants propose to amend independent claim 1 to improve form and clarity.

Upon entry of this Amendment, claims 1-14 remain pending, with claims 15-20 withdrawn from consideration as drawn to a nonelected invention. Applicants respectfully traverse the rejection for the following reasons.

Rejection of Claims 1-14 under 35 U.S.C. § 112, second paragraph:

The Examiner rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (Office Action, p. 2). In particular, the Examiner stated that "[he] cannot discern the claimed physical relationship between a treatment current supplying means, an electric power supply and said electric power source" (Office Action, p. 2).

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

In response, Applicants propose to amend independent claim 1 to even more clearly define the invention and to overcome the rejection. Applicants therefore request withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph. Applicants also request withdrawal of the rejection of dependent claims 2-14 under 35 U.S.C. § 112, second paragraph.

Rejection of Claims 1-13 under 35 U.S.C. § 103(a):

Applicants traverse the rejection of claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Ya Man LTD. No *prima facie* case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P. § 2141(II)*. "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P. § 2141(III)*.

Here, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 1 calls for a combination including, for example, "[a]n electrode for treatment ... comprising: ... a receiving means for receiving a radio control signal proper for said treatment electrode transmitted from said controller; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said radio control signal" (emphasis added). The cited references fail to teach at least this element of claim 1.

Yamazaki discloses that "[t]hose planar electrodes H1, H2, H3 and H4 are to contact to the approximation of the waist of the user" (para. [0054]). Yamazaki further discloses that "[t]hose button projections 6 correspond to a button recess 7 connecting a cable 59 and cable 3 with detachable structure. Therefore, the planar electrodes H1, H2, H3 and H4 are connected electrically to a control unit 2 through the button

projection 6, button recess 7, cables 59 and 3" (para. [0055], emphasis added).

However, Yamazaki does not teach not suggest "a receiving means for receiving a radio control signal proper for said treatment electrode transmitted from said controller; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said radio control signal," as recited in claim 1 (emphasis added).

The Examiner admitted that "Yamazaki does not disclose a receiving means for receiving an external control signal at radio transmission" (Office Action, p. 3).

However, the Examiner alleged that "Yamazaki discloses ... a portable controlling means 2 for controlling said treatment current supplying means on the basis of a control signal received by the conducting pad 5" (Office Action, p. 3, emphasis added).

Whether this allegation is correct or not, Yamazaki does not teach "a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said radio control signal [transmitted from said controller]," as recited in claim 1 (emphasis added).

As indicated by the Examiner, "Yamazaki discloses a body contacting stimulation system containing a portable controller 2 wherein control signals are sent from the controller 2 to conducting electrode belt 5" (Office Action, p. 8, emphasis added).

However, claim 1 recites, among other things, "a receiving means for receiving a radio control signal proper for said treatment electrode transmitted from said controller; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said radio control signal," (emphasis added). In other words, the claimed "radio control signal" is transmitted from the

"controller," but not from the claimed "controlling means." Accordingly, neither the controller 2 of Yamazaki, which sends control signals, nor any other component of Yamazaki, can constitute the claimed "controlling means for controlling the operation of said treatment electrode ... on the basis of said radio control signal [transmitted from said controller]," as recited in claim 1.

The Examiner further alleged that Ya Man LTD teaches "an electrode treatment device that contains a portable control unit 1 that transmits control signals via a transmission antenna to a receiving antenna on the treatment apparatus in order to control the stimulation given by an electrode belt (Abstract)" (Office Action, p. 3).

However, even if this characterization of Ya Man LTD were correct, which Applicants do not concede, Ya Man LTD does not teach "[a]n electrode ... comprising: ... a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said radio control signal [transmitted from said controller]]," as recited in claim 1 (emphasis added). For example, in embodiments in Applicants' specification (see, e.g., para. [0024] - [0027] and Figs. 1-4), the control signal is transmitted from the transmitting antenna 8 of the controller 6 to the antenna 12 of the electrode. In such embodiments, the control signal controls the treatment electrode.

Ya Man LTD is directed at "a cordless type beauty treatment pulse unit" (Title). Ya Man LTD discloses that "[t]his beauty treatment pulse unit comprises a control box 1, a pulsed power source 2, a belt electrode 3 ... and a tights electrode 4" (Abstract). Ya Man LTD also discloses that "[t]he control box 1 converts a treatment type designated via its color liquid crystal panel P and the associated feed pattern into

control signals, and sends them to the pulsed power source 2 via a transmission antenna 12" (Abstract). Ya Man LTD further discloses that "[u]pon receiving the control signals via a reception antenna 22, the pulses power source 2 generates pulses of prescribed width and frequency. The belt electrode 3 has planar electrodes 32 that ... are connected to the pulsed power source 2 ... [and t]he tights electrode 4 also has planar electrodes 42 that are ... connected to the pulsed power source 2 via ... cables 44" (Abstract).

Therefore, according to Ya Man LTD, the transmission of control signals is conducted between the control box 1 and the pulsed power source 2, then the supply of the current to the belt electrode 4 is conducted between the pulsed power source 2 and the belt electrode 4 via the cables 44. However, Ya Man LTD does not teach or suggest "[a]n electrode ... comprising: ... a controlling means for controlling the operation of said treatment electrode ... on the basis of said radio control signal [transmitted from said controller]," as recited in claim 1 (emphasis added).

Furthermore, according to Ya Man LTD, the belt electrode 3 is only configured as an electrode. There is no teaching that the belt electrode 3 contains electric components such as "an electric power source," "a treatment current supplying means," or "a receiving means for receiving a radio control signal proper for said treatment electrode," as recited in claim 1.

Therefore, neither Yamazaki nor Ya Man LTD, nor any combination thereof, teaches "[a]n electrode ... comprising: ... a receiving means for receiving a radio control signal proper for said treatment electrode transmitted from said controller; and a controlling means for controlling the operation of said treatment electrode through said

treatment current supplying means on the basis of said radio control signal," as recited in claim 1 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. Independent claim 1 is therefore allowable, and dependent claims 2-13 are also allowable at least by virtue of their dependence from base claim 1. The 35 U.S.C. § 103(a) rejection of claims 1-13 is therefore improper and should be withdrawn.

Rejection of Claim 14 under 35 U.S.C. § 103(a):

Applicants traverse the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Ya Man LTD, further in view of Granek. No *prima facie* case of obviousness has been established.

Claim 14 depend upon base claim 1. As explained above, neither Yamazaki nor Ya Man LTD, nor any combination thereof, teaches "[a]n electrode ... comprising: ... a receiving means for receiving a radio control signal proper for said treatment electrode transmitted from said controller at radio transmission; and a controlling means for controlling the operation of said treatment electrode through said treatment current

supplying means on the basis of said radio control signal," as recited in claim 1 and required by claim 14 (emphasis added).

Granek fails to cure the deficiencies of Yamazaki and Ya Man LTD. The Examiner alleged that "Granek teaches a garment apparatus for delivering and receiving electrical impulses" (Office Action, p. 6). However, whether this allegation is correct or not, neither Yamazaki nor Ya Man LTD, nor Granek, nor any combination thereof, teaches "[a]n electrode ... comprising: ... a receiving means for receiving a radio control signal proper for said treatment electrode transmitted from said controller at radio transmission; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said radio control signal," as recited in claim 1 and required by claim 14 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claim 14 is therefore improper and should be withdrawn.

Conclusion:

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-14 in condition for allowance. The proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate and favorable action by the Examiner.

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 1-14 are in condition for allowance. Accordingly, Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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